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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,511	11/14/2000	David K. Gifford	06543-002006	8013

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EXAMINER	
MEINECKE DIAZ, SUSANNA M	
ART UNIT	**PAPER NUMBER**
3623	

DATE MAILED: 02/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)	
Office Action Summary	09/711,511	GIFFORD, DAVID K.	
	Examiner	**Art Unit**	
	Susanna M. Diaz	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 January 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 24, 2005 has been entered.

Claim 5 has been added.

Claims 1-5 are pending.

Response to Arguments

2. Applicant's arguments filed January 24, 2005 have been fully considered but they are not persuasive.

Applicant argues that the art rejection does not address limitations that should be read into the claims from the specification based on an invocation of 35 U.S.C. 112, 6th paragraph. However, Applicant specifically points out, "There is no mention of any kind of network transfer protocols or hypertext conventions of the WWW (see, e.g. specification page 11, second paragraph)." (Page 6 of Applicant's response) While the claims are read in light of the specification, not all limitations will be incorporated into the claims from the specification. Regarding means-plus-function language, only the structure needed to perform the recited functionality is read into the claims from the

specification. In the instant case, a processor, storage device, and network (as taught by the Bush reference) are needed to perform the recited functionality. The specific network transfer protocols and hypertext conventions of the WWW are not structural limitations *per se* nor does the specification clarify that they are inherent to the structure corresponding to the recited means-plus-function language. Therefore, Applicant's arguments are moot because they are directed toward limitations not incorporated, either expressly or implicitly (under 112, 6th paragraph), in the claims.

Furthermore, Applicant argues that the Examiner's line of reasoning is illogical because, based on this line of reasoning, "any algorithmic process or apparatus would become anticipated or obvious once any reference discloses a processor, storage device and network." (Page 6 of Applicant's response) Applicant adds, "In a means-plus-function claim in which the disclosed structure is a computer, or microprocessor, programmed to carry out an algorithm, the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm." (Page 6 of Applicant's response) The Examiner never stated that any general purpose computer *per se* would read on the claimed invention. Instead, Bush discloses a processor, storage device, and network, which perform the functionality in claims 1, 2, and 4; therefore, it is understood that Bush's processor, storage device, and network are all programmed to specifically perform these functions.

Applicant continues to argue:

> The "means for communicating a digital advertisement" is clearly disclosed as being communicated by a merchant computer over a computer network, having advertisements stored in databases (see, e.g., specification

> pages 10-11). In contrast, *Bush* discloses a transmission being made by a transmitting source using a video signal that includes characters generated from a video character generator 206 (col. 1, lines 56-67; col. 3, lines 1-7; col. 5, lines 50-59; col. 6, lines 25-34). Also, "the means for requesting, displaying and responding to digital advertisements" are supported in the specification, for example, on pages 11-13, and illustrate the use of links, and provides HTML forms for interacting with users. No such structure is taught or suggested in *Bush*." (Page 6 of Applicant's response)

Again, Applicant desires that too many details be read from the specification into the claims. Applicant, for example, references various characteristics of the disclosed means for communicating, not all of which are limited to the structure of the means for communicating itself. In other words, the fact that a means for communicating a digital advertisement can communicate with a merchant over a computer network, having advertisements stored in databases does not necessarily mean that the structure of such means for communicating itself comprises the databases. Nor is it appropriate to read in the details of the entire network that, consequently, is *external to* the means for communicating into the claim. The layout of the network and the databases do not define the means for communicating *per se* and therefore are not read in as structural limitations attributed to said means for communicating under 35 U.S.C. § 112, 6th paragraph. Similarly, "the use of links, and...HTML forms for interacting with users" does not define any structure *per se* that is disclosed in the specification as necessarily read into the recited "means for requesting, displaying and responding to digital advertisements." If Applicant desires that these features be read into the claims, then it

is respectfully suggested that Applicant amend the claims to expressly incorporate these limitations.

In summary, the Examiner deems Applicant's arguments to be non-persuasive and the art rejection is maintained.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Bush (U.S. Patent No. 5,475,585).

Bush discloses a network sales system comprising:

[Claim 1] a plurality of buyer computers and at least one merchant computer interconnected by a communications network (col. 1, lines 8-27, 56-59 -- Bush's invention is targeted to customers of cable TV, thereby implying that multiple cable customers may access Bush's service via cable transmission; Fig. 1A),

means at each merchant computer for maintaining and providing a database of digital advertisements (Fig. 1A; col. 3, lines 1-20; col. 5, lines 10-19) comprising:

means for storing said digital advertisements, each digital advertisement including a product abstract (Figs. 1A-5, 8; col. 3, lines 52-54; col. 8, lines 3-8 -- The electronically communicated and displayed menu of various artists performing in a selected location is indicative of a database of digital advertisements with corresponding instructions that are programmed to cause the advertisements to be displayed. Also, a brief description, i.e., an abstract, of various products and services may be advertised to a customer),

means for communicating a digital advertisement to a buyer computer over said network in response to a network request from said buyer computer (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8),

means at each buyer computer for requesting, displaying, and responding to digital advertisements (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8) comprising:

means responsive to a user inquiry for selecting a merchant computer and obtaining a digital advertisement for a product from said database of advertisements at said merchant computer (Figs. 1A-5, 8; col. 3, lines 1-20; col. 4, line 67 through col. 5, line 23; col. 8, lines 3-8),

display means for displaying said advertisement (col. 3, lines 1-20; col. 8, lines 3-16),

purchase means responsive to a user request for communicating a purchase message to said merchant computer (Figs. 1A-5, 8; col. 3, lines 50-54; col. 4, line 67 through col. 5, line 23; col. 8, lines 3-16),

account identification means to authorize said purchase message by sending messages into a financial system network (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48),

means, at said merchant computer, comprising:

authorization means to authorize said purchase message by sending messages into a financial system network (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 4, line 67 through col. 5, line 23; col. 6, lines 46-48 -- In one scenario, the merchant computer must submit transaction information to the financial system network in order to provide a cross-check before the financial transaction is verified, as explained in detail in col. 3, line 60 through col. 4, line 10),

fulfillment means to send said product to user conditional on approval of said authorization means (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48; col. 8, lines 13-16, 30-42 -- Ordered tickets or software are delivered to the user after processing payment);

[Claim 3] wherein said account identification means comprises:

means for assembling a payment order (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48),

means for sending said payment order to a network payment system for authorization (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48),

and wherein said authorization means comprises:

means for verifying that said payment order has been previously authorized by said payment system (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48).

Bush discloses an electronic sales system comprising:

[Claim 4] means for storing a database of digital advertisements, each digital advertisement for a product including a program (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8 -- The electronically communicated and displayed menu of various artists performing in a selected location is indicative of a database of digital advertisements with corresponding instructions that are programmed to cause the advertisements to be displayed),

means for communicating a digital advertisement to a buyer computer (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8),

means at said buyer computer for displaying and responding to said digital advertisement (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8) comprising:

display means for displaying said digital advertisement by executing a portion of said advertisement as a program and performing actions as specified by said program (col. 3, lines 1-10; col. 8, lines 3-16),

purchase means responsive to a user request for communicating a purchase message to a merchant computer (Figs. 1A-5, 8; col. 4, line 67 through col. 5, line 23; col. 8, lines 3-16),

means, at said merchant computer, comprising:

fulfillment means to send said product to said user (col. 3, lines 52-54; col. 8, lines 13-16, 30-42 -- Ordered tickets or software are delivered to the user after processing payment).

[Claim 5] Claim 5 recites limitations already addressed by the rejection of claim 4 above; therefore, the same rejection applies. Furthermore, it should be noted that Bush's "means for communicating a digital advertisement to a buyer computer" may be packet-switched means. See at least col. 5, lines 7-9; col. 6, lines 4-9; and col. 10, lines 58-64 of Bush.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bush (U.S. Patent No. 5,475,585), as applied to claim 1 above.

[Claim 2] Bush discloses an authorization means at the merchant computer (as discussed in the rejection of claim 1 above); however, Bush does not expressly teach the details of what occurs if it is determined that certain payment information is missing. Official Notice is taken that it is old and well-known in the art of financial transactions to request additional information if needed to complete a financial transaction. For

example, Bush specifically addresses credit card transactions and it is old and well-known to request additional credit card information when needed. This additional information may include a credit card holder's address, security code, name as exactly printed on the credit card, etc. The request for additional information during a credit card transaction provides added security for the transaction (e.g., verification that the card has not been stolen or is not being used by someone not in possession of the actual card). The limitations of claim 2 are merely directed toward the means for electronically performing such a request for missing information; therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt Bush's electronic credit card authorization means to incorporate means for communicating a missing payment information request message to said buyer computer to obtain missing payment information, means for receiving said missing payment information from said buyer computer, means for authorizing said purchase message by sending messages into a financial system network, wherein said account identification means at said buyer computer comprises means responsive to said missing payment information request message to query the user for additional payment information and means to send said additional payment information to said merchant computer in order to facilitate the quick and efficient retrieval of additional information needed to complete a credit card transaction, thereby providing added security for the transaction (e.g., verification that the card has not been stolen or is not being used by someone not in possession of the actual card).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 7, 2005

Susanna Diaz
SUSANNA M. DIAZ
PRIMARY EXAMINER
AU 3623